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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,795

Applicant(s)

WRIGHT ET AL.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 10/24/05, with respect to the rejection(s) of claim(s) 1-2,7-11, 13-15, 17-21 , 23, and 34-35 under 35 USC 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tahara et al (5,909,551).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-2,7-11, 13-15, 17-21 , 23, 25 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,241,668) in view of Tahara et al (5,909,551)

Regarding claims 1,2, 13 -15 , 23 and 34-35, Herzog discloses a system (Figs. 1-2) for recording a first set of medical image data on a portable digital recording medium, comprising: a receiving module configured to receive said first set of medical image data from camera or recorder or scanner); a processing module 22 configured to process said first set of medical image data; and an output module configured to transmit said first set of medical image data to a first device (CD writer) configured to record said first set of medical image data on said portable digital recording medium (CD), wherein a viewing program configured to view said first set of medical image data is stored on said portable digital recording medium (column 3, lines 40-50, column 4, lines 15-23).

Regarding claim 2, further teaches the viewing program is recorded on said portable digital recording medium by said first device.

Regarding claims 7-8 ,18-19 and 25, Herzog further teaches the portable digital recording medium is an optical disk and is a CD (column 3, lines 40-50).

Regarding claims 9 and 17, Herzog further teaches the output module is configured to transmit said second set of medical image data to said first device (Fig. 1 column 3).

Regarding claims 10,11 and 20-21, Herzog further teaches the receiving module is configured to receive said first set of medical image data from an image server (Fig.

1, column 3).

Herzog fails to specifically teaches recording viewing program on the medium.

Tahara teaches a recording apparatus for recording images and a viewing program on a medium, the viewing program configured to view the image data. (See Abstract, column 7, lines 40-68).

It would have been obvious to one of ordinary skill in the art to modify Herzog with Tahara by using a viewing program recording means as taught by Tahara for recording a viewing program with the images on the medium of Herzog thereby enabling viewing the images when needed.

4. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,241,668) in view of Tahara et al (5,909,551) as applied to claims 1-2 above, further in view of Nishihara et al (5,272,625).

Regarding claims 3-4, Herzog fails to teach the first device is configured to print a label on said portable digital recording medium.

Nishihara teaches a system for receiving the image data and associated labels and for storing the image data and associated label on a file (column 10, lines 20-35).

It would have been obvious to one of ordinary skill in the art to modify Herzog with Nishihara by providing the images data of Herzog with associated labels thereby enhancing the capability of the system of Herzog in retrieving the images data.

Herzog as modified with Nishihara fails to specifically teaches the use of a printer for printing the labels.

However, it is noted that using a printer for printing an image from a stored or received image is well known in the art. Therefore, Official Notice is taken and it would have been obvious to one of ordinary skill in the art to modify Herzog as modified with Nishihara by using a printer for printing the label on the disc.

5. Claim 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,241,668) in view of Tahara et al as applied to claims 1-4 above further in view of in view of Stoodley (US 2004/0078236 A1).

Regarding claims 5 and 16, Herzog fails to teach creating audit information. However, it is noted that creating audit information for a device is well known in the art for purpose of billing as taught by Stoodley (section 0019, page 1). Therefore, it would have been obvious to one of ordinary skill in the art to modify Herzog with Stoodley by using a means for creating audit information for the recording medium of Herzog for billing purposes.

6. Claims 6, 12, 22, and 26-29, 31, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,241,668) in view of Tanaka (6,564,256).

Regarding claims 6, 23, 26-29, 31, 33 and 36, Herzog discloses a system (Fig. 1) for recording a first set and second set of medical image data on a portable digital recording medium, comprising: a receiving module configured to receive said first set of medical image data; a processing module configured to process said first set of medical image data; and an output module configured to transmit said first set of medical image

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data to a first device configured to record said first set of medical image data on said portable digital recording medium (CD) (column 3, lines 40-48, column 4 line 15-25), wherein a viewing program configured to view said first set of medical image data is stored on said portable digital recording medium column 2, lines 20-68).

Herzog fails to teaches a transmitting means for retrieving and transmitting a plurality of medical image sets to plurality of user terminal . Tanaka teaches a system having transmitting means for retrieving and transmitting a plurality of medical images sets to user terminals and a browser at each user terminal for browsing the medical images transmitted to the terminals (column 8, lines 45-65). It would have been obvious to one of ordinary skill in the art to modify Herzog with Tanaka providing the system of Herzog with a browser as taught by Tanaka in order to enhancing the capability the Herzog system for facilitating selecting, viewing and recording the medical image sets.

Further for claims 36, the combination of Herzog and Tanaka further teaches a first production device and a second production device since Herzog teaches recording of the image data from a server on a medium (Figs. 1,2) and Tanaka teaches a plurality of terminals , each terminal can access the image data from a server based on a the terminal request.

Regarding claims 12 and 22, Herzog as modified with Tanaka further teaches receiving the medical images in DICOM format (See Tanaka ,column 4, lines 31-40).

Applicant argues that "In contrast to the teachings of Herzog and Tanaka, amended Independent Claim 29 recites a method that comprises, among other things,

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performing a search of said computer database for medical data related to the selected first set of said medical image data, wherein results of said search are compiled into a second set of medical data; and

recording said selected first set of medical Image data and said compiled second set of medical data on said portable digital recording medium.

Applicants respectfully submit that these elements are taught by neither Herzog nor Tanaka. Applicants have amended independent Claim 29 to clarify that a search is performed "for medical data related to the selected first set of medical image data", and that the "selected first set of medical image and said compiled second set of medical data" are recorded onto the portable digital recording medium. In contrast to the recitations of amended independent Claim 29, Herzog simply teaches that digital optical images acquired by a digital imaging modality, a digital image archive, or a scanner are directly recorded to a compact disc. Neither Herzog nor Tanaka contains any teaching of "performing a search". Therefore, Applicants submit that amended independent Claim 29 is patentable over the combination of Herzog and Tanaka, and respectfully request that this rejection be withdrawn".

In response the examiner disagrees . It is noted that Herzlog teaches that the image data store on the medium is retrieved for viewing . Since the image data stored as files or programs in a data base or an optical disc (CD) , and each file has a specified ID (patient ID) . In order to retrieve a file for viewing or observing , the system of Herzlog must perform a search for the file in data base or on CD) (See Herzlog column 3, lines 10-65) .

Applicant argues that "In contrast to the teachings of Herzog and Tanaka, amended independent Claim 31 recites a system that comprises, among other things, a processing module configured to (a) process said first set of medical image data, (b) search a medical data storage unit for medical data related to said first set of medical image data, and (c) compile results of the search into a second set of medical data; and an output module configured to transmit said first set of medical image data and said second set of medical data to a production device configured to record said first set of medical image data and said second set of medical data on said portable digital recording medium. Applicants respectfully submit that this element is taught by, neither Herzog nor Tanaka. Applicants have amended independent Claim 31 to clarify that the processing module is configured to 'search a medical image data storage unit for medical data related to said first set of medical image data', among other things. In contrast to amended independent Claim 31, Herzog simply teaches that digital optical images acquired by a digital imaging modality, a digital image archive, or a scanner are directly recorded to a compact disc. Neither Herzog nor Tanaka contains any teaching of a module that is configured to "search a medical data storage unit". Based on the foregoing, Applicants submit that amended independent Claim 31 is patentable over the combination of Herzog and Tanaka, and respectfully request that this rejection be withdrawn. "

In response the examiner disagrees . It is noted that Herzog teaches that the image data store on the medium is retrieved for viewing . Since the image data stored as files or programs in a data base or an optical disc (CD) , and each file has a

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specified ID (patient ID) . In order to retrieve a file for viewing or observing , the system of Herzlog must perform a search for the file in data base or on CD) (See Herzlog column 3, lines 10-65) .

Furthermore,. because dependent Claim 33 depends from amended independent Claim 31, and further recites additional novel and nonobvious features, Applicants submit that dependent Claim 33 is allowable for at least the same reasons that amended independent Claim 31 is allowable. Thus, Applicants respectfully request that this dependent claim rejection be withdrawn as well.

Regarding claim 36. Applicant argues that " Independent Claim 36 stands rejected as being unpatentable over Herzog in view of Tanaka. In contrast to the teachings of Herzog and Tanaka, amended independent Claim 36 recites a method comprising, among other things, connecting sold application server to a first production device and a second production device, said first production device and said second production device each configured to record said first set of medical image data on said portable digital recording medium selecting, on the basis of said first set of medical image data, a target production device from a list of said first production device and said second production device. Applicants respectfully submit that these elements are ,taught by neither Herzog nor Tanaka. Herzog discusses a system that includes only one compact disc writer, and Tanaka does not even teach use of a production device configured to record data on a portable digital recording medium. Therefore, neither Herzog nor Tanaka disclose "a first production device and a second production device" (emphasis

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added) as recited in amended independent Claim 36. Furthermore, because neither Herzog nor Tanaka disclose a first production device and a second production device, neither reference teaches "selecting ... a target production device". Therefore, Applicants submit that amended independent Claim 36 is patentable over the combination of Herzog and Tanaka: and respectfully request that this rejection be withdrawn".

In response the examiner disagrees. It is noted that Herzlog teaches the image data stored in a sever can be distributed to a terminal or PC via a internet and Tanaka teaches using a plurality of terminals to access the image data from a internet based upon the request from each terminal . Each terminal or PCs can be considered a production device . Therefore it is clear that the combination of Herzog and Tanaka teaches a first production device and a second production device and both the first production device and second production device can recorded the image data from the server on a medium . Further the combination of Herzog and Tanaka teaches that the image data are distributed from a server to the PCs or terminals for viewing by user or doctors , each of terminal receiving image data is on a list of application server and the image data from application server can be distributed to a target production device.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herzog (6,241,668) in view of Tahara (5,909,551) as applied to claims 23 above , further in view of in view of Stoodley (US 2004/0078236 A1).

Regarding claim 24, Herzog fails to teach creating audit information . However, it is noted that creating audit information is well known in the art for purpose of billing as taught by Stoodley (section 0019, page 2). Therefore, it would have been obvious to one of ordinary skill in the art to modify Herzog with Stoodley by using a means for creating audit information for the recording medium of Herzog for billing purposes.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sutherland et al teaches recoding and distributing on medical network.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HUY NGUYEN
PRIMARY EXAMINER